

ROBERT E. BUSHNELL\*†

JOSEPH G. SEEBER\*  
DARREN R. CREW\*  
MATTHEW J. LESTINA†  
SARYADVINDER S. SAHOTA†  
JONG H. PARK†  
FRANK J. DYNDAL\*

OF COUNSEL  
RICHARD H. STERN\*

MICHAEL D. PARKER  
(REG. PATENT AGENT)

† ADMITTED IN MARYLAND  
\* ADMITTED IN VIRGINIA  
+ ADMITTED IN PENNSYLVANIA  
‡ ADMITTED IN NEW YORK  
§ ADMITTED IN CONNECTICUT  
\* ADMITTED IN NEW JERSEY  
\* NOT ADMITTED IN D.C.

Attn.: SPE Lee Young  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Fax No.: (703) 746-4251

**R. E. BUSHNELL**

ATTORNEY AT LAW

1522 K STREET, N.W., SUITE 800  
WASHINGTON, D.C. 20005-1202  
UNITED STATES OF AMERICA

30 December 2003

## INTELLECTUAL PROPERTY LAW

TELEPHONE (202) 408-9040  
FACSIMILE (202) 289-7100  
FACSIMILE (202) 628-3835  
FACSIMILE (410) 747-0022  
E-MAIL: REBUSHNELL@AOL.COM

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JAN 02 2004

**OFFICIAL**

Re: U.S. Patent National Stage Application for:  
*CLOSED INJECTION MOULDED CLOSURE*  
Serial No.: 09/890,154  
Louis Lagler, et al.  
Int'l App. No.: PCT/IB99/00277  
Our Ref.: P56559PCT  
Total Pages Including this Page: 12

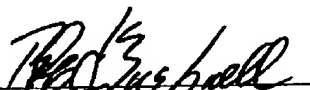
Dear Examiner Young:

Accompanying this facsimile transmission is a Petition under 37 CFR §1.181 in response to the Examiner's requirement that Figure 1 be designated as "PRIOR ART" in the Office action (Paper No. 8) mailed 23 April 2003, a copy of which is being concurrently filed in the U.S. PTO.

Kindly acknowledge receipt of all pages.

With best regards.

Respectfully submitted,

  
Robert E. Bushnell

REB/wc  
Enclosure

☞ If you did not receive all of the pages, please call the following number: (202) 408-9040

PATENT  
P56559PCT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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JAN 02 2004

OFFICIAL

In re Application of: LOUIS LAGLER *et al.*

U.S. Serial No.: 09/890,154

Examiner: HYLTON, R.

U.S. Filing Date: 23 October 2001

Art Unit: 3727

I. A. No.: PCT/CH99/00510

I.A. Filing date: 30 October 1999

Priority date: 27 January 1999

For: CLOSED INJECTION MOULDED CLOSURE PROVIDING MATING UPPER  
AND LOWER PARTS COUPLED BY INTEGRALLY FORMED HINGE  
CONNECTIONS (as amended)

**PETITION UNDER 37 CFR §1.181****Mail Stop :**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Office action (Paper No. 8), mailed 23 April 2003, Applicant respectfully  
petitions from the Examiner's requirement that Figure 1 be designated as "PRIOR ART," because  
only that which is old is illustrated, and as reasons therefore, states that:

Folio: P56559PCT

Date: 30 December 2003

I.D.: REB/wc

PATENT  
P56559PCT**STATEMENT OF FACTS**

1. On the 23 April 2003, the Examiner mailed a Office action (Paper No. 8). Paper No. 8 mentioned that the Examiner required labeling Figure 1 as "Prior Art".
2. Three copies of Decisions on Petition for the following references previously issued by Group Directors are enclosed:
  - Paper No. 21 issued on 25 February 1998 for U.S. Application SN. 08/447,279 filed on 22 May 1995;
  - Paper No. 15 issued on 2 October 1996 for U.S. Application SN. 08/343,939 filed on 17 November 1994; and
  - Paper No. (unknown) issued on 15 December 1999 for U.S. Application SN. 08/985,544 filed on 5 December 1997.
3. Nothing in Applicant's specification states that Figure 1 constitute "Prior Art" as that term is defined by 35 U.S.C. §103 by reference to the several paragraphs of 35 U.S.C. §102.
4. In a response to Paper No. 8 that was timely filed on the 23<sup>rd</sup> of September 2003, Applicant explained the impropriety of the requirement to label Figure 1 as "Prior Art", and requested reconsideration of this requirement and withdrawal of the requirement to label Figure 1 as "Prior Art."

PATENT  
P56559PCT

5. As of the 29<sup>th</sup> of December 2003, more than three months after Applicant's filing of the response on the 23<sup>rd</sup> of September 2003, the requirement to label Figure 1 as "Prior Art" has not been withdrawn.

PATENT  
P56559PCT**ARGUMENTS AND/OR REMARKS**

In Paper No. 8, the Examiner erroneously maintained the objection on Figure 1 to be labeled as "Prior Art". The Examiner states:

"Figure 1 should be designated by a legend such as--Prior Art--because only that which is old is illustrated.

MPEP §608.02(g) states:

Figures showing the prior art are usually unnecessary and should be cancelled, *Ex parte Elliott*, 1904 C.D. 103; 109 O.G. 1337. However, where needed to understand applicant's invention, they may be retained if designated by a legend such as "Prior Art."

If the prior art figure is not labeled, the following paragraph may be used.

Figure should be designated by a legend such as Prior Art in order to clarify what is applicant's invention. (See MPEP w 608.02(g)).

First, in Paper No. 8, the Office action dated 23 April 2003, the Examiner asserted that "Figure 1 should be designated by a legend such as--Prior Art--because only that which is old is illustrated" in cited §608.02(g) of the *Manual Patent Examining Procedure*. The term "Prior Art" is defined by statute, not by the MPEP. Specifically, 35 U.S.C. §102. Nothing in any paragraph of §102 however, states that subject matter "which is *old*" constitutes prior art, as asserted by the Examiner in page 2 of the Office action, Paper No. 8. In short, the age of the subject matter does not convert that subject matter into prior art, as the term "prior art" is defined by the law of the United States. Consequently, the Examiner's sole rationale for imposing the requirement that Figure 1 be labeled as "Prior Art" is contrary to statute and improper. The requirement must therefore be

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P56559PCT

withdrawn.

**Second,** Fig. 1 is not itself believed to constitute "PRIOR ART" as that term is defined by either 35 USC §102 or 35 USC §103. As evidenced from the Declaration/Oath, the Applicant is a citizen of Switzerland, and, as such, devised Fig. 1 in Switzerland in order to illustrate Applicant's discovery of problems plagued in the art. Therefore, since there is no showing that Fig. 1 was known to anyone other than the Applicant *in this country* nor is there a showing that Fig. 1 was *patented or published in this country or a foreign country*, then Fig. 1 can not be deemed to be "Prior Art" absent evidence to the contrary.

**Third,** Fig. 1 is simply an abstract representation of the art prepared by the Applicant in an effort to illustrate Applicant's discovery of problems plagued in the art in accordance with 37 CFR §1.83(b); this discovery is itself, together with Appellant's abstraction of the art represented by Fig. 1, part of the Applicant's invention. By identifying deficiencies in the prior art and then addressing those deficiencies, Applicant completes the inventive process. As such, Applicant's effort to identify deficiencies or other undesirable features in the art, does not constitute "Prior Art" as that term is used under 35 USC §103, and defined by 35 USC §§102(a)-(g).

**Fourth,** Applicant has never made any statement asserting that Fig. 1 was "Prior Art". If the Examiner is relying on the Applicant's use of the word "conventional" to mean "known by others in this country", then the Examiner is incorrect. The present application is based on, and is a translation

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P56559PCT

of, Swiss Application Serial No. PCT/IB99/00277, on which the Applicant has claimed priority as evidenced by the Declaration (Oath). Accordingly, the term "conventional" can, at most, only be considered with respect to Switzerland, not this country. MPEP §706.02©) states, in part:

"The language "in this country" means in the United States only and does not include other WTO or NAFTA member countries."

If the Examiner is relying on the Applicant's use of the word "conventional" to mean "patented or published in this country or a foreign country", then the Examiner is again incorrect. There is no evidence that Fig. 1 exists in any printed form other than in the present application and its priority document. There is evidence to indicate that Applicant devised the subject matter in Fig. 1 however, and that evidence lies in the fact that the only existence of Fig. 1 is in the present application and its priority document.

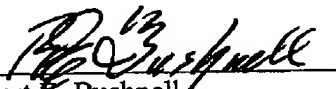
PATENT  
P56559PCT

**REMEDY REQUESTED**

The Commissioner is respectfully requested to:

- A. Withdraw the requirement to label Fig. 1 as "Prior Art";
- B. Grant Applicant such other and further relief as justice may require.

Respectfully submitted,

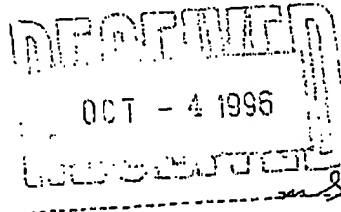
  
Robert E. Bushnell  
Attorney for Applicant  
Reg. No.: 27,774

1522 "K" Street, N.W., Suite 300  
Washington, D.C. 20005  
Area Code: 202-408-9040  
Folio: P56559pct  
Date: 30 December 2003  
I.D.: REB/wc





ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231



#15

In re Application of  
MYUNG-CHAN JEONG  
Serial No: 08/343,939  
Filed on : November 17, 1994  
For: DIGITAL SERVO CONTROL  
APPARATUS AND METHOD  
OF DATA STORAGE SYSTEM  
USING DISK RECORDING  
MEDIA

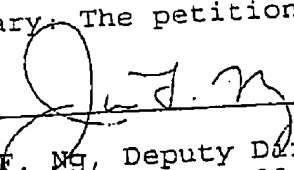
DECISION ON PETITION  
UNDER 37 CFR 1.181

This is a decision on the petition filed on September 13, 1996  
requesting the withdrawal of the requirement to label Fig. 3 as  
"Prior Art".

The petition is GRANTED.

A review of the record indicates that figure 3 as originally  
filed and discussed was referred to as "CONVENTIONAL". Hence, in  
keeping with the disclosure and petitioner's arguments, the  
examiners' requirement to label this figure as "Prior Art" is  
incorrect and withdrawn.

Summary: The petition is Granted.

  
Jin F. Ng, Deputy Director  
Examining Group 2500  
Electrical and Optical Systems  
and Devices

JFN/AMP

Robert E. Bushnell  
1511 K Street N.W.  
Washington, D.C. 20005

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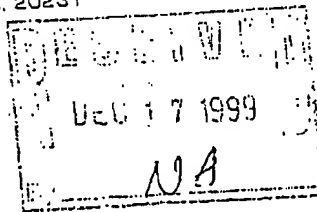
OCT 2 - 1996

OFFICE OF THE DIRECTOR  
GROUP 2500

DEC 15 1999

Office of the Director  
Group 3600

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Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231



ROBERT E BUSHNELL  
ATTORNEY-AT-LAW  
1522 K STREET, N.W., SUITE 300  
WASHINGTON, D.C. 20005-1202

In re application of  
Hae-Won Ahn  
Serial No.: 08/985,544  
Filed: December 5, 1997  
For: FRONT CASE STRUCTURE OF CRT  
DISPLAY DEVICE

P54947

DECISION ON PETITION  
UNDER 37 CFR §1.181  
REQUESTING THAT  
THE COMMISSIONER  
INVOKE SUPERVISORY  
AUTHORITY

In the renewed petition filed September 9, 1999, applicant requested that the Commissioner invoke supervisory authority by instructing the examiner to withdraw the requirement that Figs. 1 and 2 be labeled as "Prior Art". The petition is GRANTED.

This petition presents two issues. First, are the figures in question necessary to the understanding of the invention? A review of the application has been made and it is considered that the figures are necessary to the understanding of the invention. Second, are the figures required to be labeled with the legend "Prior Art"?

A careful review of the application papers indicates that the subject matter of Figures 1 and 2 are considered by applicant to be "conventional". However, there is no indication in the disclosure that the subject matter of the figures is expressly considered by the applicant to be "Prior Art". If applicant states that something is prior art, it is available for use against the claims. See *In re Nomiya*, 184 USPQ 607 (CCPA 1975), MPEP §2129. No opinion is expressed in this decision whether the subject matter of Figures 1 and 2 are "Prior Art" since this is an appealable issue, MPEP §1201.

Finally, any concerns raised in the previous decision regarding applicant's duty of disclosure are withdrawn. The Office does not normally investigate such issues. 1135 Off. Gaz. Pat. Office, 13 (Jan. 9, 1992).

This application is being forwarded to the examiner for reinstatement of Figs. 1 and 2 and deletion of the amendment after final filed August 4, 1999.

Al Lawrence Smith, Director  
Technology Center 3600  
(703) 308-1020

AK

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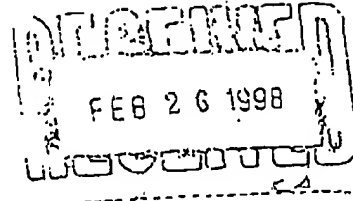
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FEB 25 1998

Director's Office  
Group 2700

Paper No. 21

Robert E. Bushnell  
1511 K. Street N.W.  
Suite 425  
Washington, D.C. 20005

In re Application of  
Gwon-Il Kim  
Application Serial No.  
08/447,279  
Filed: May 22, 1995  
For: SERVO CONTROLLER  
APPARATUS AND METHOD  
OF DISK RECORDING  
SYSTEM

DECISION ON RENEWED  
PETITION UNDER  
37 C.F.R. § 1.181

This is a decision on the renewed petition filed August 25, 1997 under 37 C.F.R. § 1.181 of the repeated requirement of the Examiner to label Applicant's Figures one through three as "prior art". The petition is treated as a request for reconsideration of the previous decision of August 19, 1997 in which the requirement of labeling figures one through three as "prior art" was maintained.

A careful review of the application papers indicates that the subject matter of figures one through three is considered by applicant to be "conventional". However, there is no indication in the disclosure that the subject matter of the figures is expressly considered by the applicant to be "prior art". "When applicant states that something is prior art, it is taken as being available as prior art against the claims. Admitted prior art can be used in obviousness rejections. In re Nomiya, 184 USPQ 607, 610 (CCPA 1975) (Figures in the application labeled "prior art" held to be an admission that what was pictured was prior art relative to applicant's invention.)" See M.P.E.P. § 2129. The decision, supra, was cited by both petitioner and the deciding official in the previous petition. Whether the subject matter of figures one through three of the instant application is prior art against the claims is an appealable determination and, accordingly, will not be entertained in this decision, see M.P.E.P. § 1201.

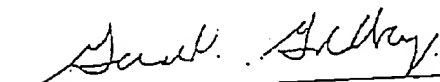
There is no requirement that a particular figure or figures be labeled as "prior art". The MPEP at section 608.02(g) indicates that if prior art figures are to be retained in the file they

should be designated with the legend of "prior art". No requirement is made for an applicant to label figure(s) as "prior art" where there is no such indication in the disclosure.

Consequently, the requirement that figures one through three each be designated by the legend of "prior art" is withdrawn.

As the time for perfecting the appeal under 37 C.F.R. § 1.192(a) has expired without the submission of an Appeal Brief, the appeal is hereby dismissed, 37 C.F.R. § 1.192(b). The application file will be forwarded to the examiner for appropriate action in due course.

SUMMARY: Petition GRANTED.



Gerald Goldberg, Director  
Technology Center 2700-  
Communications and Information Processing